

## REMARKS

This is a full and timely response to the outstanding final Office Action mailed July 24, 2007. Upon entry of the amendments in this response, claims 21 and 23 – 38 remain pending. In particular, Applicants amend claim 21 and cancel claim 22 without prejudice, waiver, or disclaimer. Applicants cancel claim 22 merely to reduce the number of disputed issues and to facilitate early allowance and issuance of other claims in the present application. Applicants reserve the right to pursue the subject matter of these canceled claims in a continuing application, if Applicants so choose, and do not intend to dedicate the canceled subject matter to the public. Reconsideration and allowance of the application and presently pending claims are respectfully requested.

### **I. Applicants' Previous Response Complies with All Requirements**

More specifically, the Office Action alleges "Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references" (OA page 2, line 5). Additionally, the Office Action asserts "Applicants arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited... Further, they do not show how the amendments avoid such references or objections" (OA page 2, line 8). Applicants respectfully traverse these allegations. More specifically, 37 CFR 1.111(b) – (c) states:

(b) In order to be entitled to reconsideration or further examination, the applicant or patent owner must reply to the Office action. The reply by the applicant or patent owner must be reduced to a writing which ***distinctly and specifically points out the supposed errors in the examiner's action and must reply to every ground of objection and rejection in the prior Office action. The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references.*** If the reply is with respect to an application, a

request may be made that objections or requirements as to form not necessary to further consideration of the claims be held in abeyance until allowable subject matter is indicated. The applicant's or patent owner's reply must appear throughout to be a *bona fide* attempt to advance the application or the reexamination proceeding to final action. A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section.

(c) In amending in reply to a rejection of claims in an application or patent under reexamination, ***the applicant or patent owner must clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made.*** The applicant or patent owner must also show how the amendments avoid such references or objections.

***(emphasis added)***

Applicants submit that every previous response has clearly pointed out the errors in the previous Office Action by indicating that *Marsh* (the cited art) fails to disclose or suggest all of the claimed elements and indicating the elements not disclosed. Applicants additionally presented arguments regarding the deficiencies of *Marsh* and pointed out the patentable novelty by not only citing excerpts of the cited art by line and page number, but also comparing these excerpts against the specific elements of the rejected claims. For at least these reasons, the previous response fully complied with all requirements.

## **II. Rejections Under 35 U.S.C. §102**

### **A. Claim 21 is Allowable Over *Marsh***

The Office Action indicates that claim 21 stands rejected under 35 U.S.C. §102(e) as allegedly being anticipated by U.S. Patent Number 6,931,657 ("*Marsh*"). Applicants respectfully traverse this rejection on the grounds that *Marsh* does not disclose, teach, or suggest all of the claimed elements. More specifically, claim 21 recites:

A selectable recording device for providing recording options to record at least a portion of a particular program, the particular program including a plurality of content streams, the device comprising:

a storage device configured to store program information received from an input source, wherein the program information includes a plurality of content streams for a plurality of program events, ***the plurality of content streams including an audio stream for the program, a video stream for the program, and a data stream for the program***; and

a processor configured to:

***provide a user option to select a desired subset of the plurality of content streams for the particular program event for recording, wherein the subset excludes at least one available content stream from the program event***; and

receive user input indicating the desired subset of content streams from the program event for recording.

***(emphasis added)***

Applicants respectfully submit that claim 21, as amended, is allowable over *Marsh* for at least the reason that *Marsh* fails to disclose, teach, or suggest a “selectable recording device for providing recording options to record a least a portion of a particular program, the particular program including a plurality of content streams, the device comprising... a storage device configured to store program information received from an input source, wherein the program information includes a plurality of content streams for a plurality of program events, ***the plurality of content streams including an audio stream for the program, a video stream for the program, and a data stream for the program***... and a processor configured to... ***provide a user option to select a desired subset of the plurality of content streams for the particular program event for recording, wherein the subset excludes at least one available content stream from the program event***” as recited in claim 21, as amended. More specifically, the Office Action cites *Marsh*, column 4, line 60 to column 6, line 8 to assert that “*Marsh* shows an example of which subset or identifiable characteristic (content segments – meaning a portion of a particular program containing a plurality of content streams) that can be found in the EPG database to include or exclude for recording, for example, selectively identifying a show with Ms. Julia Roberts but not guest appearances on talk shows” (OA page 3, line 24).

Applicants respectfully disagree with this analysis. More specifically, within the passage cited by the Office Action, *Marsh* states “if Ms. Roberts were to appear as a guest on the next

episode of the Late Show With David Letterman, then intelligent content agent 108 would automatically identify the next episode of the Late Show With David Letterman as a candidate program for recording” (column 5, line 32). Additionally, also within the Office Action’s cited passage, *Marsh* states “should Ms. Roberts or Mr. Letterman fail to mention ‘Major League Baseball’ during the program, then intelligent content agent 108 may decide to delete the recorded program entirely” (column 7, line 50). As illustrated, in these passages and confirmed throughout the entire reference, *Marsh* appears to disclose that a program is either recorded or not recorded or that a segment of a program is either recorded or not recorded. There is absolutely no mention of providing an option to select only a subset of the program streams for recording, such as recording only an audio stream of a program, only a video stream of a program, or only a data stream of a program. Similarly, *Marsh* makes absolutely no mention of recording only the audio and video streams (and excluding the data stream), recording only the audio and data streams (and excluding the video stream), or recording only the video and data streams (and excluding the audio stream) of a program.

As illustrated above, *Marsh* fails to even suggest anything remotely resembling “a storage device configured to store program information received from an input source, wherein the program information includes a plurality of content streams for a plurality of program events, ***the plurality of content streams including an audio stream for the program, a video stream for the program, and a data stream for the program***... and a processor configured to... ***provide a user option to select a desired subset of the plurality of content streams for the particular program event for recording, wherein the subset excludes at least one available content stream from the program event***” as recited in claim 21, as amended. For at least this reason, claim 21, as amended, is allowable over the cited art.

**B. Claim 28 is Allowable Over *Marsh***

The Office Action indicates that claim 28 stands rejected under 35 U.S.C. §102(e) as allegedly being anticipated by U.S. Patent Number 6,931,657 ("*Marsh*"). Applicants respectfully traverse this rejection on the grounds that *Marsh* does not disclose, teach, or suggest all of the claimed elements. More specifically, claim 28 recites:

A method for providing recording options to a user, comprising:  
receiving program information, wherein the program information includes a plurality of content streams for at least one of a plurality of program events;  
providing a user option to ***select a desired subset of content streams for a particular program event for recording, wherein the subset excludes at least one available content stream from the program event***; and  
receiving user input indicating the desired subset of content streams from the program event for recording.

***(emphasis added)***

Applicants respectfully submit that claim 28 is allowable over *Marsh* for at least the reason that *Marsh* fails to disclose, teach, or suggest a "method for providing recording options to a user, comprising... providing a user option to ***select a desired subset of content streams for a particular program event for recording, wherein the subset excludes at least one available content stream from the program event***" as recited in claim 28. More specifically, the Office Action cites *Marsh*, column 4, line 60 to column 6, line 8 to assert that "*Marsh* shows an example of which subset or identifiable characteristic (content segments – meaning a portion of a particular program containing a plurality of content streams) that can be found in the EPG database to include or exclude for recording, for example, selectively identifying a show with Ms. Julia Roberts but not guest appearances on talk shows" (OA page 3, line 24).

Applicants respectfully disagree with this analysis. More specifically, within the passage cited by the Office Action, *Marsh* states "if Ms. Roberts were to appear as a guest on the next episode of the Late Show With David Letterman, then intelligent content agent 108 would automatically identify the next episode of the Late Show With David Letterman as a candidate

program for recording” (column 5, line 32). Additionally, also within the Office Action’s cited passage, *Marsh* states “should Ms. Roberts or Mr. Letterman fail to mention ‘Major League Baseball’ during the program, then intelligent content agent 108 may decide to delete the recorded program entirely” (column 7, line 50). As illustrated, in these passages and confirmed throughout the entire reference, *Marsh* appears to disclose that a program is either recorded or not recorded or that a segment of a program is either recorded or not recorded. There is absolutely no mention of providing an option to select only a subset of the program streams for recording, such as only an audio stream of a program, only a video stream of a program, or only a data stream of a program. Similarly, *Marsh* makes absolutely no mention of recording only the audio and video streams (and excluding the data stream), recording only the audio and data streams (and excluding the video stream), or recording only the video and data streams (and excluding the audio stream) of a program.

As illustrated above, *Marsh* fails to even suggest anything remotely resembling “method for providing recording options to a user, comprising... providing a user option to ***select a desired subset of content streams for a particular program event for recording, wherein the subset excludes at least one available content stream from the program event***” as recited in claim 28. For at least this reason, claim 28 is allowable over the cited art.

### **C. Claim 33 is Allowable Over *Marsh***

The Office Action indicates that claim 33 stands rejected under 35 U.S.C. §102(e) as allegedly being anticipated by U.S. Patent Number 6,931,657 (“*Marsh*”). Applicants respectfully traverse this rejection on the grounds that *Marsh* does not disclose, teach, or suggest all of the claimed elements. More specifically, claim 33 recites:

A system for providing recording options to a user, comprising:  
a receiver configured to receive program information from an input source, the program information including a plurality of content streams for a at least one of a plurality of program events; and  
a control system configured to:

***provide a user option to select a desired subset of the plurality of content streams for a particular program event of the plurality of program events, wherein the subset excludes at least one available content stream from the program event***, and

receive a user command indicating the desired subset of content streams from the program event for recording.

***(emphasis added)***

Applicants respectfully submit that claim 33 is allowable over *Marsh* for at least the reason that *Marsh* fails to disclose, teach, or suggest a “system for providing recording options to a user, comprising... a control system configured to... ***provide a user option to select a desired subset of the plurality of content streams for a particular program event of the plurality of program events, wherein the subset excludes at least one available content stream from the program event***” as recited in claim 33. More specifically, the Office Action cites *Marsh*, column 4, line 60 to column 6, line 8 to assert that “Marsh shows an example of which subset or identifiable characteristic (content segments – meaning a portion of a particular program containing a plurality of content streams) that can be found in the EPG database to include or exclude for recording, for example, selectively identifying a show with Ms. Julia Roberts but not guest appearances on talk shows” (OA page 3, line 24).

Applicants respectfully disagree with this analysis. More specifically, within the passage cited by the Office Action, *Marsh* states “if Ms. Roberts were to appear as a guest on the next episode of the Late Show With David Letterman, then intelligent content agent 108 would automatically identify the next episode of the Late Show With David Letterman as a candidate program for recording” (column 5, line 32). Additionally, also within the Office Action’s cited passage, *Marsh* states “should Ms. Roberts or Mr. Letterman fail to mention ‘Major League Baseball’ during the program, then intelligent content agent 108 may decide to delete the recorded program entirely” (column 7, line 50). As illustrated, in these passages and confirmed throughout the entire reference, *Marsh* appears to disclose that a program is either recorded or not recorded or that a segment of a program is either recorded or not recorded. There is absolutely no mention of providing an option to select only a subset of the program streams for

recording, such as only an audio stream of a program, only a video stream of a program, or only a data stream of a program. Similarly, *Marsh* makes absolutely no mention of recording only the audio and video streams (and excluding the data stream), recording only the audio and data streams (and excluding the video stream), or recording only the video and data streams (and excluding the audio stream) of a program.

As illustrated above, *Marsh* fails to even suggest anything remotely resembling “a control system configured to... ***provide a user option to select a desired subset of the plurality of content streams for a particular program event of the plurality of program events, wherein the subset excludes at least one available content stream from the program event***” as recited in claim 33. For at least this reason, claim 33 is allowable over the cited art.

**D. Claims 23 – 27, 29 – 32, 34 – 35, and 38 are Allowable Over *Marsh***

The Office Action indicates that claims 23 – 27, 29 – 32, 34 – 35, and 38 stand rejected under 35 U.S.C. §102(e) as allegedly being anticipated by U.S. Patent Number 6,931,657 (“*Marsh*”). Applicants respectfully traverse this rejection on the grounds that *Marsh* does not disclose, teach, or suggest all of the claimed elements. More specifically, dependent claims 23 – 27 are believed to be allowable for at least the reason that these claims depend from allowable independent claim 21. Dependent claims 29 – 32 are believed to be allowable for at least the reason that these claims depend from allowable independent claim 28. Further, dependent claims 34 – 35 and 38 are believed to be allowable for at least the reason that these claims depend from allowable independent claim 33. *In re Fine, Minnesota Mining and Mfg. Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002).

**III. Rejections Under 35 U.S.C. §103 – Claims 36 – 37 are Allowable Over *Marsh* in view *Hoffberg***

The Office Action indicates that claims 36 – 37 stand rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over U.S. Patent Number 6,931,657 (“*Marsh*”) in view of U.S. Patent Number 6,418,424 (“*Hoffberg*”). Applicants respectfully traverse this rejection for at least the reason that *Marsh* in view of *Hoffberg* fails to disclose, teach, or suggest all of the elements of claims 36 – 37. More specifically, dependent claims 36 – 37 are believed to be allowable for at least the reason that these claims depend from allowable independent claim 33. *In re Fine, Minnesota Mining and Mfg.Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002).

## **CONCLUSION**

In light of the foregoing amendments and for at least the reasons set forth above, Applicants respectfully submit that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the now pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested.

Any other statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all findings of well-known art and Official Notice, or statements interpreted similarly, should not be considered well-known for the particular and specific reasons that the claimed combinations are too complex to support such conclusions and because the Office Action does not include specific findings predicated on sound technical and scientific reasoning to support such conclusions.

If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,

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